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In re Application of
Tian-Qiang Sun et al.
Serial No. : 09/919,585
Filed : 30 July 2001
Attorney Ref No. : 59516-147/PP-16093.002

Decision on Petition

This letter is in response to the Petition under 37 C.F.R. 1.181, filed on 23 November 2004, to request that the Examiner enter the amendment filed on August 19, 2004 and allow claims 1-6, for reasons discussed herein or alternatively request that the Examiner withdraw the finality of the previous Office Action, enter the amendment filed on August 18, 2004, conduct a search of the full pending and elected subject matter, and issue a Notice of Allowance or a non-final action. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that the application was filed on July 30, 2001 with 25 claims.

A requirement for restriction was mailed to applicants on October 1, 2002. In this paper the examiner required the restriction of the 25 claims into six different groups and the examiner additionally required applicants select from one of Groups A, B, C and D drawn to different polypeptides and their encoding polynucleotides (i.e. SEQ ID NOs). On April 1, 2003 applicants elected Group I, claims 1-6, directed to nucleic acids, vectors, host cells and methods of expression of said nucleic acids and group B comprising the nucleotide sequence of SEQ ID NO: 4 and amino acid sequence SEQ ID NO: 6 without traverse. On May 6, 2003 the examiner sent applicants a first action on the merits with rejections under 35 U.S. C. 112 first and second paragraphs and 35 U.S.C. 102(b) on all claims being examined (i.e. claims 1-6). On November 23, 2003 applicants responded with amendments to the claims and argument supporting applicants position. On February 20, 2004 a final rejection was sent to applicants maintaining rejections under 35 U.S. C. 112 first and second paragraphs and 35 U.S.C. 102(b) on all claims being examined (i.e. claims 1-6). On August 19, 2004 applicants submitted an after-final amendment of the claims deleting all reference to SEQ ID NO: 4 from the claims and arguments. On October 13, 2004, an advisory action was sent to applicants stating that the proposed amendment after-final would not be entered because they raise new issues that would require further consideration and/or search. This proposed amendment in addition to raising new issues such as an additional search, further deleted a "second parenthesis" which the examiner stated would lead to a new objection. On November 3, 2004, applicants' representative and the examiner further discussed the basis for the non-entry of applicants proposed amendment as

outlined in the interview summary made of record. On November 23, 2004 applicants filed the petition discussed herein.

DISCUSSION

Applicants petition under 37 C.F.R. 1.181, filed on 23 November 2004, to request that the Examiner enter the amendment filed on August 19, 2004 and allow claims 1-6, for reasons discussed herein or alternatively request that the Examiner withdraw the finality of the previous Office Action, enter the amendment filed on August 18, 2004, conduct a search of the full pending and elected subject matter, and issue a Notice of Allowance or a non-final action.

Applicants request as a first alternative, that the Examiner indicate on the record that claim 1 is allowable over the cited art, as applicants suggest that this conclusion seems implicit in the Examiner's statement in the Office Action dated April 20, 2004 at page 9 in which it was stated:

"Applicants comments are noted, however, the rejection remains. Applicants attention is drawn to amended claim 1 parts (d), (f), (g), (h), (j) and (k)... all of which remain anticipated by Espinosa et al."

Applicants suggest that if the entirety of claim 1 was anticipated by Espinosa, it seems there would be no need to specify certain parts that remained anticipated following entry of an amendment and thus applicants submit that they were justified in relying on the unlisted parts (claim 1(a), (b), and (c)) as not being anticipated by the cited art.

Applicants' conclusions as to the allowability of certain claims based upon statements made in response to applicants comments regarding previous rejections are unsubstantiated. It is noted that in response to the referred to previous art rejection based on Espinosa et al., applicants amended the claim and merely stated:

"Without acquiescing to the ground of rejection, applicants submit that the claims as amended are not subject to this ground of rejection."

This being the only argument presented beyond applicants amendment of the claims supporting applicants position that "All of the claims remaining in the application are now clearly allowable.", the examiner responded with the above direction to specific portions of the claim which obviously applicants had overlooked. Applicants should read no more into such statements then to direct applicants to portions of the claim which applicants had clearly overlooked.

Applicants are reminded that once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). **Ordinarily, amendments filed after the final action are not entered unless approved by the examiner.** See MPEP § 706.07(f), § 714.13 and § 1207.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first reply, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

Claims 1-6 were considered to the extent of their patentability and currently remain rejected under 35 U.S.C. 112 first and second paragraph as well as under 35 U.S.C. 102(b) over Espinosa et al. These rejections were first applied in the non-final office action mailed to applicants on 5/6/2003. Applicants had prior to this action a number of opportunities to argue and amend the claims to overcome the current rejections.

DECISION

For these reasons, the Petition under 37 C.F.R. 1.181 to request that the Examiner enter the amendment filed on August 19, 2004 and allow claims 1-6, for reasons discussed herein or alternatively request that the Examiner withdraw the finality of the previous Office Action, enter the amendment filed on August 18, 2004, conduct a search of the full pending and elected subject matter, and issue a Notice of Allowance or a non-final action is **DENIED**.

Any request for consideration of this petition decision must be filed within two (2) months of the mailing date of this decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-872-9306.

A handwritten signature in black ink, appearing to read "Bruce Kisliuk".

Bruce Kisliuk

Director, Technology Center 1600.